

REMARKS

The Applicant is filing this Response to Office Action in response to an Official Action dated February 23, 2007. At the time of the Official Action, claims 14-46 were pending. In this Response and Amendment, no claims are canceled or added. Accordingly, claims 14-46 remain currently pending.

Claim Rejections under the Doctrine of Obviousness-Type Double Patenting

In the Office Action, the Examiner rejected claims 14-46 under the judicially created doctrine of obviousness-type double patenting over claims 1-20 of U.S. Patent No. 6,600,503, which is the parent of the present continuing application. Although Applicants do not concede that the present claims 14-46 are obvious over claims 1-20 of the parent application, the Applicants are willing to file a terminal disclaimer to further prosecution of the case when the claims are indicated as allowable.

The Rejection Under 35 U.S.C. § 102(e)

In the Office Action, claims 14-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,025,837 to Matthews, III et al. (“the Matthews reference”). With respect to the rejection of claims 14-46 under Section 102 based on the Matthews reference, Applicants are submitting herewith a declaration pursuant to 37 C.F.R. §1.131 along with supporting evidence sufficient to remove the Matthews reference as prior art.

To establish prior invention, an applicant must present a “showing of facts [that] shall be such, in character and weight, as to establish...conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to

a subsequent reduction to practice or to the filing of the application.” 37 C.F.R. § 1.131(b). Applicants respectfully submit that such a showing is made by Declaration of Richard Lawson Under 37 C.F.R. § 1.131 (“the Lawson Declaration”), and the accompanying exhibits.¹

On its face, the Matthews reference has an actual filing date of March 29, 1996 and there is no priority claim to other applications. As such, the earliest possible date on which the Matthews patent may rely for priority is March 29, 1996. Applicants respectfully assert that the accompanying Rule 131 declaration establishes conception of the instant invention prior to March 29, 1996. Additionally, Applicants assert that the accompanying exhibits establish diligence prior to that date up to the filing of U.S. Ser. No. 08/726,628 (now U.S. Pat. No. 6,600,503) on October 7, 1996. U.S. Ser. No. 08/726,628 is a grandparent application of the instant application and will be referred to herein as “the grandparent application.”

As set forth in the Lawson Declaration, Mr. Lawson and co-inventors John P. Stautner and Brian V. Belmont, conceived of the subject matter of the instant application prior to March 29, 1996. Lawson Declaration, ¶ 4. The conception is evidenced by a “General Background and Description of the Invention” document, a “Product Profile” document, and concept sketches. Each of the documents was prepared prior to March 29, 1996 and true and correct redacted copies are attached as Exhibits A, B, and C, respectively.

¹ Co-inventors John P. Stautner and Brian V. Belmont are no longer employed with HP. As such, they are not available to provide declarations. The Applicants respectfully submit that, under the circumstances, the Lawson Declaration and supporting exhibits are the best evidence available of the conception of the invention.

Specifically, as set forth in the Lawson Declaration, Mr. Lawson, John Stautner, and Brian Belmont conceived of an integrated content guide that delivers content selection information to be displayed as a content selection guide. *See* Lawson Declaration, ¶ 5; Exhibit A, pages 2-3, “3. The Integrated Content Guide”; Exhibit B page 1, “The Product Description”; Exhibit C, Fig. 1. The integrated content guide provides content selection information from a plurality of content sources to a user, the content selection information comprising descriptive information associated with the content available from the plurality of content sources, the content selection information being adapted to be displayed within a plurality of selectable guide cells. Exhibit A, pages 2-3 and 5, “3. The Integrated Content Guide” and “3.5 Integration of Multiple Sources”; Exhibit B, pages 2-3, “Product Features”; Exhibit C, Figs. 2-3. Additionally, the integrated content guide defines an action to be associated with content selection information that is to be displayed in at least one of the selectable guide cells. *Id.* The integrated content guide also defines an indicator within the at least one of the selectable guide cells, the indicator corresponding to the action, to allow the user to initiate the action by selecting the indicator. Exhibit A, at pages 3-4, “3.1 Embedded Icons”; Exhibit B, pages 2-3 “Product Features”; Exhibit C, Figs. 2-3.

With respect to diligence from the conception evidenced by Exhibits A, B and C to the time of filing of the grandparent application on October 7, 1996, Applicants submit herewith Exhibits D through U, which document the significant activity undertaken to prepare the grandparent application. Exhibit D purports to be a redacted email sent from Compaq’s Legal Department confirming receipt of an invention disclosure for the subject matter of the instant application. Exhibit E purports to be a copy of a redacted letter from Compaq’s Legal Department to a law firm requesting a quote for the preparation of a patent application for the subject matter of the instant application. Exhibit F purports to

be a redacted internal memorandum of the law firm requesting that a file be opened for a patent application for the subject matter of the instant application.

Exhibit G purports to be a letter from the law firm to Compaq's legal department forwarding a first draft of a patent application for the subject matter of the instant application and a redacted fax cover sheet evidencing transmission of the letter and draft application. Exhibit H purports to be a redacted internal memorandum of the law firm indicating that the inventors are still reviewing the application. Exhibit I purports to be a redacted fax message from the law firm to a patent draftsman indicating that minor changes to the figures as needed. Exhibit J purports to be a redacted letter from the law firm to the Compaq legal department forwarding a copy of the patent application, which was revised in view of inventor feedback.

Exhibit K purports to be a redacted letter from the law firm forwarding a declaration for the inventors to sign. Exhibit L purports to be a redacted letter from the law firm to the Compaq legal department forwarding a further revised draft of the patent application. Exhibit M purports to be a redacted fax cover sheet from the law firm to co-inventor Brian Belmont forwarding pages which include changes to the patent application and a copy of the new FIG. 5 for review. Exhibit N purports to be a redacted letter forwarding still another revised draft of the patent application incorporating further inventor feedback and formal papers for the application. Exhibit O purports to be a redacted letter from the law firm to Compaq forwarding yet another revised version of the patent application.

Exhibit P purports to be a redacted letter to Mr. Lawson forwarding a revised draft of the application and a new declaration and assignment. Exhibit Q purports to be a redacted copy of a letter from the law firm forwarding a copy of a letter sent to Mr. Lawson (Exhibit P) to the Compaq legal department. Exhibit R purports to be a redacted letter from the law firm to co-inventor Brian Belmont forwarding a copy of the patent application and formal papers for Mr. Belmont's signature. Exhibit S purports to be a redacted fax cover sheet from the law firm transmitting a redacted executed assignment for the patent application to Compaq. Exhibit T purports to be a redacted letter from Compaq forwarding a Power of Attorney for the patent application to the law firm. Exhibit U purports to be a transmittal letter attesting to the filing of the grandparent patent application on October 7, 1996.

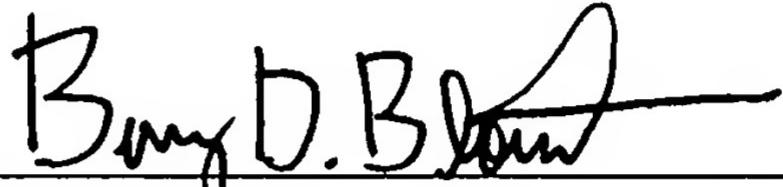
Based on these facts, the Applicants respectfully assert that a showing has been made that the invention disclosed and claimed in the instant patent application was conceived prior to March 29, 1996. Additionally, diligent efforts were made from the time of conception through the filing of the grandparent application on October 7, 1996. Thus, the Applicants respectfully assert that prior invention has been demonstrated with respect to the Matthews reference. Because of the Applicants' prior invention, the Matthews reference is not prior art to the instant application. Accordingly, Applicants respectfully assert that the rejections of claims 14-46 based on the Matthews reference should be withdrawn. An indication of the allowability of all claims is earnestly solicited.

Conclusion

In view of the remarks set forth above, the Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of all pending claims 14-46. If

the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Date: June 21, 2007

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